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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/658,622

09/09/2003

Toby E. Smith

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EXAMINER

MULLEN, THOMAS J

ART UNIT

PAPER NUMBER

2632

DATE MAILED: 09/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/658,622

Applicant(s)

SMITH ET AL.

Examiner

Thomas J. Mullen, Jr.

Art Unit

2632

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 12 September 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: (SEE ATTACHED) (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☒ Applicant's reply has overcome the following rejection(s): claim 27 under 35 USC 112(1).
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: 13, 14 and 21-35.
Claim(s) objected to: 3, 7, 9-11 and 17.
Claim(s) rejected: 1, 2, 4-6, 8, 12, 15, 16 and 18-20.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____
13. ☐ Other: _____.

Art Unit: 2632

Rejection of claim 27 under 35 USC 112(1)

Applicant's arguments and evidence regarding the relationship between the terms "core" and "sheet" (as applied to optically transmissive materials) is persuasive, and this rejection is withdrawn.

New Issues & Not materially simplifying the Issues

In claims 1 and 15, changing "significantly changed location" to --moved significantly-- is considered to raise a new issue that would require further consideration and/or search. Furthermore, in view of part (a) in each claim where the language "determining...a location of the patient" is used, the amendments to parts (c1) and (c2) in each claim result in different language being used to describe the functioning of the "sensor", and thus the proposed amendment does not materially simplify the issues for appeal.

Rejection of claims 1-2, 4-6, 8, 12, 15-16 and 18-20 under 35 USC 102(e) (Menkedick et al)

Applicant alleges that limitations from the specification have not been improperly "read into" the claims (as discussed in In re Self, 213 USPQ 1,5 (CCPA 1982)), and yet argues that the phrase "significant movement" (or "significantly changed location", as is recited in two places in each of claims 1 and 15) must be considered limited to "a movement to a new position which is maintained for a period of time sufficient to allow for tissue reoxygenation" (relying on what is described in paragraph 0089 of the specification, which teachings allegedly serve to limit the term "significantly" as used in the claims). It is maintained that there is no other way to interpret applicant's argument, than to conclude that applicant is improperly reading the limitations from paragraph 0089 in the specification into the claims, since one skilled in the art would intuitively understand that the phrase "significant movement" by itself can refer to any measurable parameter (e.g. time or distance) associated with the "movement" by which it may be characterized as "significant". Put another way, just because applicant discloses the concept of "non-significant" movements (i.e. where a patient returns to an original position within a predetermined time of initial movement) as well as disclosing "significant" movements, the claims in fact only recite the latter type, set forth in the claims as "significantly chang(ing)

Art Unit: 2632

location". Thus, the claim language does not go beyond the "significant movements"-teaching in Menkedick et al.

Further, applicant makes reference to paragraph 0055 of the specification, as comparing the phrases "significant move(ment)" and "significant...location changes"; however, what paragraph 0055 also teaches is that the standard for "significant" movement (or location change) may be based on either a "time interval" or an "amount of movement" (see paragraph 0055, lines 7-13), and not necessarily on both parameters. Thus, applicant's statements about how the specification "define(s) the term 'significant movement'" are factually flawed; and, even if the specification's limiting teachings about "significant" movement were (improperly) imported into the claims, the claims still would not be limited to the extent argued by applicant.

Thus, it is maintained that Menkedick et al inherently teaches monitoring "significant" movement in the "bed sores" embodiment (which is discussed at col. 15, line 63 to col. 16, line 10) to at least the extent required by the claims, either in the sense of monitoring which of the discretely-placed sensors (70,104) are actuated by the patient as he moves about (or stays in one position) on the support surface (36,38), i.e. monitoring a "significant" change in position associated with the "movement", or by the monitoring of the "predetermined period of time, such as two hours" in which movement must occur (col. 16, lines 2-3), i.e. monitoring a "significant" duration of time associated with the "movement".

Regarding applicant's other arguments, applicant attacks the use of the word "able" in paragraph 3 of the final rejection, completely ignoring the context in which it was used--i.e., based on the entirety of the teachings of Menkedick et al which were discussed in the same paragraph (i.e., before the phrase which includes "able"), for these reasons Menkedick et al is "able to" carry out (i.e., inherently does carry out) the function of determining a "significant movement" of a patient (as to patient position, which is only one form of "significant movement" expressly or implicitly taught in Menkedick et al).

Regarding the proposed amendment to claims 1 and 15, applicant states that such amendment "has made this rejection moot", apparently implying that changing "significantly changed location" to "moved significantly" is required (and sufficient) to distinguish the claims from Menkedick et al; however, applicant provides no specific argument in support of this statement, and it is not apparent how such proposed changes to claims 1 and 15 do anything to

Art Unit: 2632

render the rejection "moot". Later, applicant characterizes "moved significantly" as an "exact phrase", but it is not seen how this phrase is any more "exact" than the one it replaced. As to the original phrase ("significantly changed location"), the examiner never intended to imply that such phrase was not "fully consistent with and supported by the specification", only that applicant was not consistently using the claim terminology in his arguments.

Other

The proposed changes to claims 29, 31, 33--correcting the spelling of "transmissive"--would be acceptable if included in a separately-filed amendment not having the new issue mentioned above.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas J. Mullen, Jr. whose telephone number is 571-272-2965. The examiner can normally be reached on Monday-Thursday from 6:30 AM to 4 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel Wu, can be reached on (571) 272-2964. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-2600.

TJM

A handwritten signature in black ink that reads "Thomas J. Mullen, Jr." in a cursive, stylized script.

Thomas J. Mullen, Jr.
Primary Examiner
Art Unit 2632